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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,674	09/23/2003	Richard Sapienza	1028-019	1047

7590 09/20/2004

Alan B. Clement
Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,674

Applicant(s)

SAPIENZA ET AL.

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/28/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The following is not supported by the specification as originally filed.

- the subject matter of claim 9;
- inorganic acids (found in claim 14);
- the range of 2 to about 100 weight percent found in claim 17;
- the use of sorbitol in claim 23;
- the use of diethylene glycol and dipropylene glycol found in claim 24;
- the subject matter of claim 25;
- the use of gluconic acid in claim 27;
- the use of sodium bicarbonate in claim 29;
- all of the surfaces recited in claims 36-40;
- the subject matter of claims 41 and 42;
- all of the systems recited in claim 46;
- the subject matter of claims 49-55;
- all of the vegetation recited in claim 62; and
- the subject matter of claim 64.

The examiner is unable to find literal support for all of the items referred to above.

Claim Objections

2. Claims 1, 5, 14, 32, 43, 49, and 60 are objected to because of the following informalities:

In claim 1, line 5, "reactionsand" should be -- reactions and --.

In claim 5 the phrase "bottoms further" should be -- bottoms stream further --.

In claim 14, a comma should appear between the term "acids" and "carbonic".

In claim 32, a comma should appear between the term "salts" and the term "sodium".

In claim 43, Claim1" should be -- Claim 1 --.

In claim 49, line 1, the term "be" should be -- by --.

In claim 60, "/andor" should be -- and/or --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrase "glycerol contain by products of triglyceride hydrolysis reactions glycerol" is not understood. What exactly is application trying to say?

Clarification is requested.

In claim 3 the phrase "said saponification by-product" appears to lack proper antecedent basis.

In claim 6 the phrase "said triglyceride processing by-product" appears to lack proper antecedent basis.

In claim 8 the phrase "said monoalcohols" appears to lack proper antecedent basis as claim 6 only refers to "a monoalcohol". Applicant needs to use consistent terminology.

In claim 9 the phrase "the transesterification reactor effluent" appears to lack proper antecedent basis.

In claim 16 the phrase "said base catalyst" appears to lack proper antecedent basis.

In claim 18 it is unclear as to what is meant by the phrase "other hydrogenation products of sugars". Also the Markush grouping recited in part (a) is confusing as according to the specification "maltitol" is an example of the "other hydrogenation products of sugars".

In claim 19 the phrase "the hydroxyl-containing triglyceride" appears to lack proper antecedent basis.

In claim 29 the phrase "said carbonic acid" lacks proper antecedent basis.

In claim 26 the phrase "said carboxylic acid salts" is inconsistent with the terminology used in claim 18 as claim 18 only recites "a carboxylic acid salt".

In claim 30 the phrase "said hydroxyl-containing triglyceride processing by-product" appears to lack proper antecedent basis.

In claim 32 the phrase "said hydroxyl-containing triglyceride processing by-product stream" appears to lack proper antecedent basis. The Markush grouping is confusing as according to the specification the "lignin sulfonate" component is an example of a "lignin component".

In claim 33 the phrase "said hydroxyl-containing triglyceride processing by-product stream" appears to lack proper antecedent basis.

In claim 34 the phrase "said inorganic salt" lacks proper antecedent basis.

In claim 35 the step of "adding to said surface" is unclear as it would appear that one would "apply" it to a surface not add it to a surface. Clarification is requested.

In claim 39 the phrase "the deck" appears to lack proper antecedent basis.

Claim 41 contains improper Markush terminology as "or" should be -- and --.

In claims 44-45 and 47 the phrase "is used as" is vague and indefinite as it is unclear as to how it is used as.

In claim 48 the phrase "comprising of applying" makes no sense.

In claims 49 and 51 it is unclear as to what is meant by "said solid format is achieved". What is applicant trying to say?

Claim 52 contains improper Markush terminology as "or" should be -- and --.

Claim 54 contains improper Markush terminology as "or" should be -- and --.

The preambles of claims 57 and 59 are inconsistent with that of claim 1.

The preamble of claim 60 is inconsistent with that of claim 59.

Claim 63 is inconsistent with claim 9 as claim 9 is not directed to a process. The phrase "the major portion" is vague and indefinite as "major" is a relative term.

In claim 64 the phrase "low pressure" is vague and indefinite as "low" is a relative term.

Allowable Subject Matter

5. Claims 1-64 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 2nd paragraph and the specification objections set forth in this Office action.

Information Disclosure Statement

6. The references have been considered however they are not seen to teach and/or fairly suggest the instant invention.

References Cited By The Examiner

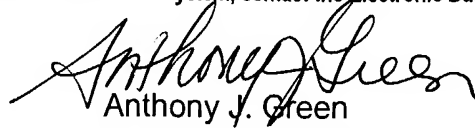
7. The references are cited as showing the general state of the art and as such, they are not seen to teach or fairly suggest the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
September 16, 2004